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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,632	07/11/2001	Darrell T. McKenzie	DANA-140	7898
23599	7590	12/03/2003	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			CECIL, TERRY K	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,632

Applicant(s)

MCKENZIE, DARRELL T.

Examiner

Mr. Terry K. Cecil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-17 and 22-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-17 and 22-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1-7-2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. The claims are objected to because of the following informalities:
 - In the preamble of claim 23, words seem to be missing between “mounting” and “disposed” (e.g. “, and being..”) and “on” should be “and”.
 - In claim 30, line 9, “portions” should be “portion”.

Appropriate correction is required.

Claim Rejections - 35 USC ' 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 13-17 and 20-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is rejected because of the following reasons:

- In independent claims 13, 23, and 30, applicant seems to have mis-described the invention:
As shown in figure 2, applicant's unitary valve *is a* unitary body of resilient flexible material that comprises elements including (1) a bypass portion and (2) upstream projections.
However, applicant has claimed a unitary valve that comprises the elements of (1) a unitary body; (2) a bypass portion; and (3) upstream projections, as if the unitary body was a separate element of the valve.

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- In claims 13 and 23, applicant's time condition "when the filter element is clogged" to describe the "spaced projections" in line 7 of the claims is unclear. Did applicant intend to delete the phrase, since the phrase also appears later in each claim?
- The following terms lack antecedent basis: "the collar portion" (claims 14 and 24; did applicant intend to claim "the collar"?); "the annular lip" (claim 29).
- Claims 14-17, 20-22 and 24-29 are also rejected since they suffer the same defects as the claims from which they depend.

Claim Rejections - 35 USC ' 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 13-14, 20, 22, 24 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et al. (U.S. 6,136,183). As shown in the figures, Suzuki discloses a unitary valve that includes a flexible unitary valve body having a bypass collar portion 41 with an annular lip sealing portion 42 sealing with the filter element. Projections—formed by passages 35 extending through end portion 33—are provided upstream of the bypass collar portion to allow fluid pressure to cause unsealing of the sealing portion when the filter element is clogged. The end

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portion 33 and the projections thereof contact both the filter element and the bypass valve portion [as in claims 13-14, 20 and 28]. The valve also includes a shelf for supporting the filter element thereon [as in claim 22]. The valve body also includes a radially extending skirt 47 overlying inlet structure of the end plate as an anti-drainback portion [as in claims 13-14, 20 and 23-24].

6. Claims 13-17 and 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Palmai (U.S. 3,669,144). As shown in the figures, Palmai discloses a unitary valve and filter support (e.g. all the parts shown in figure 1 form a unit, applicant has not defined "unitary" otherwise in the specification) that includes a flexible unitary valve body having a bypass collar portion 22 with a sealing portion 29 sealing with the filter element (against e.g. end cap 21). Ribbed projections (27, 28 and also those shown in figure 3) are provided upstream of the bypass collar portion and also extend over the radially extending anti-drainback valve 23 to allow fluid pressure to cause unsealing of the sealing portion 29 when the filter element is clogged. The ribs contact the sealing portion 29 and also the filter element adjacent the leader of 26 [as in claim 13-16 and 23-26]. The valve also includes a shelf for supporting the filter element thereon [as in claims 22-23], wherein parts are made of rubber [as in claim 17 and 27].

7. Claims 13-14, 20, 22, 24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Buckman (U.S. 3,567,023). Buckman teaches a unitary valve including a rubber valve body (figure 7) that includes a bypass portion having an annular sealing "lip" 24 and a radially extending antidrainback portion 21. Rib projections 34 are provided upstream of the bypass

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portion forming channels and a recess that supports the filter element and which extends over a portion of the antidrainback portion [as in claims 13-14, 20, 22, 24 and 28].

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 13-17 and 22-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. 6,136,183) in view of Covington (U.S. 6,096,199). As discussed in the 112 rejections section above, applicant's claims are unclear. If applicant is claiming a valve as shown in his figure 2, the following rejection also applies and demonstrates in addition to claims 13-17 and 22-29, the obviousness of claim 30. As shown in figure 2, Suzuki teaches a unitary valve that comprises a molded unitary body of resilient flexible material formed as a single element that includes a radially extending anti-drainback portion unitary with the body and overlying inlet structure into an inlet chamber through an end plate (figure 4A); and also includes a bypass valve portion 41 configured at a collar and having a lip 42 for sealing with the filter element. Although Suzuki does teach axially-extending channels through member 33, he does

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not teach the unitary body forming spaced projections or ribs engaging the filter element to form the axially-extending channels. However, Covington does teach such projections 132 that are axially-extending (see figure 12). It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the projections 132 configured into the valve 40 of Suzuki since Covington teaches the benefit of stiffening the annular valve adjacent the point that supports the filter element while still allowing flexure of the bypass portion. Upon modification the projections would form the axially-extending channels and allow the fluid pressure from the inlet chamber to be applied to the sealing portion causing unseating thereof and a flow bypassing the filter element [as in claims 13-14, 17, 20-24, 27-28 and 30]. As for claims 15-16, 25-26, and 29, the projections can be considered ribs and would also extend along the collar and over a portion of the skirt (the examiner considers the portion 48 to be part of the skirt; nothing in the claim precludes otherwise).

Double Patenting

In response to the terminal disclaimer filed 9-34-2003 (which has been approved), the double patenting rejection of the prior office action has been withdrawn.

Response to Arguments

10. Applicant's arguments filed 9-24-2003 have been fully considered but they are not persuasive because of the following reasons:

- It is pointed out that Applicant's claims (e.g. 13 and 23) concerning the projections, require only that the projections (i) be spaced; (ii) be upstream of the bypass portion; (iii) be

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disposed between and engage both the bypass portion and the filter element; and (iv) allow fluid pressure to cause a bypass flow. In contrast to the applicant's arguments, the examiner contends that the lower projections of the support elements in each of Suzuki and Buckman meet the limitations of the claims (e.g. 13 and 23) in their present form. These projections work as a unit (i.e. unitary) with the other valve elements to provide the bypass flow.

- Applicant has argued (page 9) that Palmai's ribs 27 and 28 are not the claimed projections since his ribs lie within the valve and are not disposed between the filter element and *the valve*. However, it is pointed out the claims require the projections to be disposed between and engaging the filter element and *the bypass valve portion*. As explained above, the ribs do engage both the bypass valve portion 29 and the end cap part of the filter element (note that the examiner considers flange portion 26 to be a common extension of the projections).
- Suzuki, in view of Connelly, has been applied in view of applicant's amendments to the claims and also demonstrate the obviousness of his invention.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on

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the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (703)305-0079 for any inquiries concerning this communication or earlier communications from the examiner.
Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:00a to 4:30p, on at least four days during the week M-F.
- The group receptionist can be reached at (703)308-0661 for inquiries of a general nature or those relating to the status of this or proceeding applications.
- Wanda Walker, the examiner's supervisor, can be reached at (703)308-0457 if attempts to reach the examiner are unsuccessful.
- The Fax number for this art unit for official faxes is 703-872-9306.



Mr. Terry K. Cecil
Primary Examiner
Art Unit 1723

TKC
November 28, 2003